

Vanity International

Participating RespOrg

PO Box 2004

Del Mar, CA 92014

800-438-8264 858-792-8888 Fax

December 15, 2017

Marlene H. Dortch, Secretary
Federal Communications Commission
445 Twelfth Street, S.W.
12th Street Lobby, Room TW-A325
Washington, D.C. 20554

Re: Docket 17-192, CC Docket No. 95-155. In the matter of Toll Free Service Access Codes, Toll Free Assignment Modernization, filed December 15, 2017.

On behalf of the Association of Toll Free Professionals (ATFP), we hereby submit Ex Parte comments regarding the above-captioned matter:

Ex Parte Comments of ATFP on the Irrelevance of the Lanham Act

Members and associates of ATF Professionals hold many of the exclusive-by-market vanity toll-free programs in existence today, create intellectual property, and have decades of toll-free experience. We hosted the original Toll-Free Summit¹ with over 30 independent vanity companies² in attendance and, more recently, gathered at the annual Somos conference. Programs such as 1-800-Home-Care, 1-800-Pavement, 1-800-Injured, 1-800-800-Cars, 1-800-Lawyers, and 1-800-Attorney are examples of exclusive-by-market licensing.

In their December 12, 2017 letter, 1-800-Flowers.com³ joins 1-800-Contacts, Inc. in the conflating trademark protected *vanity numbers* with network addressing, i.e. toll-free numbers alone. They stated in their filing, "*We strongly urge that the Commission restrain from adopting*

¹ See pictures and overview: <http://tollfreesummit.com> held in Chicago 2009, 2013, and 2014; San Diego 2011

² Companies participating in our Toll Free Summits: 1-800-Phone-Word, 1300australia.com.au, 800 Bankruptcy, 800 Cars, LLC, 800 Edge, 800-Dial-Word (formally Pathways), 800-Grooming, 800-Mercedes, 800-Response, 800PhoneNumbers.com, Amazing Numbers, ATL Communications, Broadcast Interview Source, Inc., Custom Toll Free, Deal Expert.Com, Dial 800, Hersch Inc., IT Connect, Kresch Law, More Calls Media, Mountain Marketing, One 800 Group LLC, Primary Wave, Ring-Ring, Rugly Group, Synergetics, Tele-Name Communications, TeleCompute Corp., Telesmart, Toll Free Express, US Justice, Vanity International, Wildfire Media (formally Kresch Legal), Word of Mouth Advertising, World.Com, and Your 800.

³ <https://ecfsapi.fcc.gov/file/121270154353/1-800%20Flowers%20Reply%20Comments%2012%2012%202017.pdf>

an auction approach for the distribution of toll-free numbers that are confusingly similar to marks protected by trademark law.” No such confusion exists or protection is justified.

We urge the Commission to look to the appellate decision,⁴ *HOLIDAY INNS, INC. (94-6365) v. 800 RESERVATION, INC.*, that made this fact abundantly clear— “*as a matter of law.*” This ruling is uniquely relevant because the decision rests solely on the *use* of the Holiday Inns’ trademark-protected *vanity number*, “*1-800-Holiday*,” where other elements of a Lanham Act infringement were not only obvious, but admitted by the defendant.

A *vanity number* is not a mere toll-free number— like those the Commission proposes to auction— but a *combination* of a trademark-protectable mnemonic device, the “*vanity overlay*,” with one or more⁵ network addresses. Together, they create a “vanity number.” The distinction is that a trademark only protects the word-phrase, *1-800-Holiday*, not the underlying digits, 800-465-4329, or any other digits that may be “*confusingly similar*.” The conflation presented by these trademark holders is that somehow, magically, their trademarks extend to the underlying digits of a network address and that they alone deserve “*First Right*⁶ *of Refusal*.”

Vanity Overlay	<i>1-800-Holiday</i>	Trademark Protected
Network Address	800-465-4329	Unprotected Digits-Only

In May, 1993 defendant 800-Reservations, Inc. secured and the toll-free 800-405-4329 (the “405 number”) to book Holiday Inn reservations and earn commissions. The 405 number is one-digit off from 800-465-4329 and often dialed when callers press⁷ “0” (zero) in lieu of the “o,” in *1-800-Holiday*, i.e. *1-800-H[0]liday*. In its decision, the court found as a matter of law:

“We conclude that although Holiday Inns owns trademark rights in its vanity number 1-800-HOLIDAY, it cannot claim such rights to the 405 number. It follows that the defendant, Call Management, is the rightful assignee of the telephone number 1-800-405-4329” (emphasis added).

⁴ <http://caselaw.findlaw.com/us-6th-circuit/1405242.html>

⁵ 1-800-Collect is supported by 3 toll-free numbers, numbers that translate from *Collect*, *Collect*, and *Call-Collect*

⁶ In “Land Rush 2,” 17,000 domains were “*inappropriately registered .INFO Sunrise names.*” See <https://afilias.info/news/2002/05/22/afilias-launch-land-rush-2-redistribute-info-sunrise-names>

⁷ This was far more common in the last century when Ma Bell promoted “*Dial “0” for Operator*,” i.e. dial zero.

Despite the fact that the defendant's "sole purpose" for choosing the 405 number was to intercept calls meant for *1-800-Holiday*, and readily acknowledged the "*1-800-Holiday*" as a trademark, they did not use the vanity overlay. Holiday Inns further argued that "*if the mark was adopted with the intent of deriving benefit from the reputation of [the plaintiff,] that fact alone may be sufficient to justify the inference that there is confusing similarity.*" Yet, even that was struck down by the court as a matter of law:

*Nevertheless, the **defendants' use of a protected mark or their use of a misleading representation is a prerequisite to the finding of a Lanham Act violation.** Absent such a finding, the eight-factor test of Frisch's Restaurants, Inc. is irrelevant. Holiday Inns does not offer, and our own research has not produced, a case in which the defendant neither used the offending mark nor created the confusion and yet was deemed to have committed a trademark infringement. **We believe that stretching the plain language of the Lanham Act to cover the present dispute is unjustified. As a matter of law,** therefore, we hold that Call Management, 800 Reservations, and Earthwinds Travel did not violate §§ 32 and 43 of the Lanham Act by the use of the 405 number. (emphasis added).*

Trademarks and toll-free numbers are *independent*, as we point out in our Comments⁸ and illustrate in our Reply⁹ Comments. TFNs are not "*confusingly similar... devices,*" as asserted. The clear exception is when a network address itself is used as a service mark. Empire Carpet, for example, created *secondary meaning*¹⁰ by the use of 1-800-588-2300 with a jingle.

It should be obvious to all the neither 1-800-Flowers.com nor 1-800-Contacts, Inc. use their toll-free numbers in such a manner and, therefore, their trademark arguments are overreaching and irrelevant to the orderly allocation of toll-free numbers.

Respectfully submitted,

Loren Stocker
TollFreeMarket.com
Founder, Association of Toll Free Professionals
Loren@800.net
1-800-Get-Vanity (800-438-8264)

⁸ <https://ecfsapi.fcc.gov/file/1114216544580/FCC.Comments.pdf>

⁹ [https://ecfsapi.fcc.gov/file/12071185716669/FCC.ReplyComments\(Corrected\).pdf](https://ecfsapi.fcc.gov/file/12071185716669/FCC.ReplyComments(Corrected).pdf)

¹⁰ In a subsequent filing, the PTO directed Empire to disclaim its own toll-free number as "*merely informational.*"